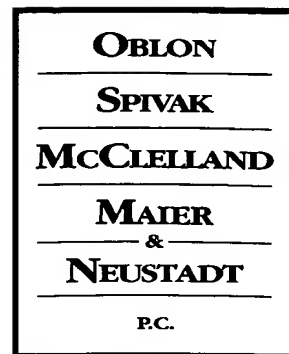




Docket No.: 251039US2

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



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RE: Application Serial No.: 10/820,851

Applicants: Masami OKAMOTO

Filing Date: April 9, 2004

For: FIXING DEVICE, IMAGE FORMING APPARATUS
INCLUDING THE FIXING DEVICE, AND FIXING
METHOD

Group Art Unit: 2852

Examiner: NGO, H.

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION OF SPECIES

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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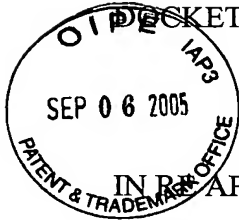
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DOCKET NO: 251039US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

MASAMI OKAMOTO

SERIAL NO: 10/820,851

FILED: APRIL 9, 2004

FOR: FIXING DEVICE, IMAGE
FORMING APPARATUS INCLUDING
THE FIXING DEVICE, AND FIXING
METHOD

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PROVISIONAL ELECTION OF SPECIES

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SIR:

In response to the Election Requirement dated August 5, 2005, Applicants provisionally elect with traverse Group I, corresponding to Figure 5, and list Claims 1, 2, 9, 15, 21, 22, 29, 35, 41, 48, 55, and 56 as readable thereon. Applicants are entitled to consideration of claims, directed to additional non-elected species, which include the limitations of an allowable generic claim, as provided by 37 C.F.R. § 1.141(a). In addition, Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicants further respectfully traverse this Election Requirement for the following reasons.

First, Applicants traverse the outstanding requirement as the outstanding requirement has not established that an undue burden would be required if the requirement was not issued and if all the claims were examined together. No undue burden is seen here since similar

subject matter must be searched and considered relative to the elected Claims 1, 2, 9, 15, 21, 22, 29, 35, 41, 48, 55, and 56. Thus, as provided under MPEP § 803:

"if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Therefore, since the restricted claims would appear to be part of an overlapping search area, it is respectfully submitted that the burden of the Examiner would be minimum. In contrast, the burden on the Applicants would be significant if Applicants were required to file and prosecute separate divisional applications.

Secondly, Applicants note that the Election of Species Requirement includes the conclusory statement that "[t]his application contains claims directed to ... patentably distinct species ..." and lists five species. However, the Election of Species Requirement fails to state any basis in support of the finding that the five species are patentably distinct. In the absence of any annunciated basis, it is respectfully submitted that the PTO has not carried forward its burden of proof to establish distinctness.

M.P.E.P. § 803 requires that "[e]xaminers must provide reasons and/or examples to support conclusions." In addition, M.P.E.P. § 806.04(f) states that "claims to be restricted to different species must recite the mutually exclusive characteristics of such species."

Although Applicants acknowledge the assertion that FIGS. 5, 7, 10, 13, and 15 are directed to patently distinct species of the claimed invention, the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species have not been mentioned as required by MPEP § 814.¹ Finally, MPEP § 816 requires that "the particular reasons relied on by the examiner for holding that the inventions as

¹ "[T]he particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to make the requirement clear." See, for example, MPEP § 814, citing *Ex parte Jungstrom*, 1905 C.D. 541, 119 O.G. 2335 (Comm'r Pat. 1905)

claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given."

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-62 be conducted.

Respectfully submitted,

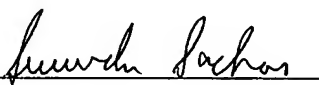
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